Remarks:

Amendments to the claims:

Claims 1, 2 and 10-19 are pending in this application. By this Amendment, claims 1, 2 and 10-19 are amended. Claims 1, 2 and 10-14 are amended to address rejections under 35 USC 101 and 112, second paragraph; claims 14, 15 and 19 are amended to correct a typographical error; and claim 16 is amended to maintain consistence with claim 15.

No new matter is added to the application by this Amendment. Support for the language added to claims 17, 18 and 19 can be found in the specification at, for example, page 4, lines 16 and 17 and claim 2 as originally filed.

Regarding the rejections of claims 1, 2 and 10-14 under 35 USC 101 and under 35 USC 112, second paragraph:

The Patent Office alleges that claims 1, 2 and 10-14 are unclear under 35 USC 112, second paragraph, because the claims provide for use of cyclooctenyl compound of formula I but fail to set forth any steps involved in the method/process. Additionally, the Patent Office alleges that claims 1, 2 and 10-14 are improper under 35 USC 101 because the claims define an improper process and fail to set forth any steps involved in the process. Applicants respectfully disagree.

Claims 1 and 2 are amended to be directed to a fragrance and claims 10-14 are amended to be directed to a fragrance application. In light of the amendments to claims 1, 2 and 10-14, Applicants submit that the rejections under 35 USC 101 and 112, second paragraph are overcome.

Applicants respectfully request withdrawal of these rejections to the claims.

Regarding the rejection of claims 1, 2 and 10-14 under 35 USC 102(b) as allegedly being anticipated by Freerksen et al. (Journal of Organic Chemistry, 1983, vol. 48, pages 4087-4096:

Applicants traverse the Examiner's rejection of claims 1, 2 and 10-14 as allegedly being anticipated by Freerkesen et al.

The Patent Office alleges that Freerksen et al. teaches 1-cyclooctene-1-enyelthanone which has a similar structure as claimed by the applicant, wherein X is carbonyl, R is ethane and the double bond is located at a position between C1 and C2. However, the Patent Office acknowledges that Freerksen fails to teach that the compound is usable as a fragrance.

Prior to discussing the relative merits of the Examiner's rejection, the applicant points out that unpatentability based on "anticipation" type rejection under 35 USC 102(b) requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee"). Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d

1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson,* 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.,* 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.,* 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.,* 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich,* 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

Nowhere does Freerksen et al. teach or suggest a fragrance comprising a compound of formula I, wherein X is carbonyl, or -(CHOH)-, and R is methyl or ethyl, or linear or branched C3 to C5 alkyl, or R is vinyl or linear or branched C3 to C5 alkenyl and the dotted line represents one optional double bond as required in amended claim 1. Instead, Freerksen et al. discloses to a procedure for the oxidative decyanation of secondary nitriles of the general formula RR'CHCN to ketones of the formula RCOR'

Because the features of independent claim 1 are neither taught nor suggested by Freerksen al., Freerksen et al. cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claims 1, 2 and 1-14 are patentably distinct from and/or non-obvious in view of Freerksen et al. Reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. §102(b) are respectfully requested.

Regarding the rejection of claim 17 under 35 USC 102(b) as allegedly being anticipated by Cantrell et al. (Journal of Organic Chemistry, 1971, vol. 36, pages 670-676):
Applicants traverse the Examiner's rejection of claim 17 as allegedly being anticipated by Cantrell et al.

The Patent Office alleges that Cantrell et al. teaches each and every feature recited in claim 17. Specifically, the Patent Office alleges that Cantrell et al. discloses an acetyl cyclooctene compound that has a similar structure as recited in claim 17, wherein X is carbonyl, R is methyl and the double bond is located in the position of the compound Ia and Ic.

Nowhere does Cantrell et al. teach or suggest a fragrance composition comprising a mixture of (A) a compound of formula Ic, and (B) a compound of formula Ia, and a compound of formula Id wherein X is carbonyl, or -(CHOH)-, R is methyl or ethyl, or linear or branched C3 to C5 alkyl or R is vinyl or linear or branched C3 to C5 alkenyl and R = R' = R" = R"' and X = X' = X" = X"' as required by amended claim 17. Instead, Cantrell et al. discloses the acetylation of cyclooctene, 1,3-cyclooctadiene, and 1,5-cyclooctadiene and a mixture of 4- acetylcyclooctane and 1-acetylcyclooctane (see the fourth paragraph on page 674 of Cantrell et al.).

Because the features of independent claim 17 are neither taught nor suggested by Cantrell et al., Cantrell et al. cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 17.

For at least these reasons, claim 17 is patentably distinct from and/or non-obvious in view of Cantrell et al. Reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. §102(b) are respectfully requested.

Regarding the rejection of claim 18 under 35 USC 102(a) as allegedly being anticipated by Bajgrowicz et al.(Bioorganic and Medicinal Chemistry, 2003, vol. 11, pages 2931-2946):

Applicants traverse the Examiner's rejection of claim 18 as allegedly being anticipated by Bajgrowicz et al.

The Patent Office alleges that Bajgrowicz et al. teaches 1-cyclyocten-1-yl-4-pentene-1-one compound, wherein X is carbonyl, R is pentenone and the double bond is located in a position between C1 and C2.

Nowhere does Bajgrowicz et al. teach or suggest a compound of formula I wherein X is carbonyl, or -(CHOH)-, and R is methyl or ethyl, or linear or branched C3 to C5 alkyl or R is vinyl or linear or branched C3 or C5 alkenyl and the dotted line represents one optional double bond as recited in amended claim 18.

Because the features of independent claim 18 are neither taught nor suggested by Bajgrowicz et al., Bajgrowicz et al. cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 18.

For at least these reasons, claim 18 is patentably distinct from and/or non-obvious in view of Bajgrowicz et al. Reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. §102(a) are respectfully requested.

Regarding the rejection of claims 15 and 16 under 35 USC 103(a) as allegedly being unpatentable over Freerksen et al. in view f U.S. Patent No. 6,555,517 to Markert et al.:

Applicants traverse the Examiner's rejection of claims 15 and 16 as allegedly being unpatentable over Freerkesen et al. in view of Markert et al.

The Patent Office acknowledges that Freerksen et al. does not teach or suggest a method of manufacturing a fragrance composition from the compound recited in claim 1 from which claims 15 and 16 depend. The Patent Office introduces Markert et al. as allegedly disclosing a method of making a fragrance composition from 4-cyclooctene aldehyde. The Patent Office alleges that 4-cyclooctene aldehyde and 1-cyclooctene-1-enyelthanone would have similar properties because the compounds have the same bone structure of cyclooctene and a functional group carbonyl. Moreover, the Patent Office alleges that, at the time of the invention, it would have been obvious to the relevant skilled artisan to substitute 1-cyclooctene-1-enylethanone for 4-cyclooctyl aldehyde in a fragrance composition for the same purpose of using 4-cyclooctyl aldehyde as perfume or perfume booster.

Prior to discussing the merits of the Patent Office's position, the undersigned reminds the Patent Office that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). See also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the

invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Neither Freerksen et al. nor Markert et al., taken singly or in combination, teaches or suggests a method of manufacturing a fragrance application, comprising the step of incorporating the compound of formula I according to claim 1 into the fragrance application as required in claim 15. Moreover, Freerksen et al. and Markert et al. fail to teach or suggest the method according to claim 15 wherein the fragrance application is a perfume, household product, laundry product, body care product or cosmetic as recited in claim 16.

Contrary to the allegations by the Patent Office, 4-Cyclooctene aldehyde of Markert et al. is described as possessing an almost unpleasantly strong smell of which the odor is reminiscent of freshly harvested potatoes (see column 3, lines 16 –18 of Markert et al.). In contrast, the presently claimed compound has a smell that is described as fruity, sweet, anisic, minty, terpineaol and camporaceous (See Example 7 of the present application). Thus, 4-cyclooctene aldehyde and 1-cyclooctene-1-enylethanone compounds do not have similar properties as alleged by the Patent.

In fact, Markert et al. teaches away from the method of claim 15 and 16 because 4-cyclooctene aldehyde possesses an almost unpleasantly strong smell of which the odor is reminiscent of freshly harvested potatoes and does not exhibit a fruity, sweet, anisic, minty, terpineaol and camporaceous as 1-cyclooctene-1-enylethanone. Further, the relevant skilled artisan would have every reason to believe that if 4-cyclooctene aldehyde (having an almost unpleasantly strong smell of which the odor is reminiscent of freshly harvested potatoes) were incorporated into a fragrance application, then such fragrance application would also exhibit the almost unpleasantly strong smell of which the odor is reminiscent of freshly harvested potatoes associated with 4-cyclooctene aldehyde. Moreover, the relevant skilled artisan would not have been led to use the 4-cyclooctene aldehyde disclosed in Markert et al. as an alternative to the 1-cyclooctene-1-enylethanone of Freerksen et al., but would have been led away therefrom in accordance with the teachings of Markert et al.

It is Applicants' viewpoint that only by "hindsight reconstruction" has the Patent Office selected among the various teachings of Freerksen et al. and Markert et al. in order to reconstruct the method as required in claims 15 and 16. However, as is well-recognized in the jurisprudence such a hindsight reconstruction is impermissible. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (CAFC, 1983); *In re Mercier* 185 USPQ 774, 778 (CCPA, 1975); *In re Geiger* 2 USPQ2d 1276 (CAFC, 1987).

In view of the foregoing remarks Applicants disagree with the Patent Office's position, traverse the Patent Office's rejection and assert that the Patent Office has not met the proper burden of proof to present and maintain the rejection; such are simply unsupported by the facts for the reasons noted above. Rather, Applicants contend that the Examiner's grounds of rejection is at, at best, a hindsight reconstruction, using Applicants' claims as a template to reconstruct the invention by picking and choosing amongst isolated disclosures from the prior art. This is impermissible under the law. Accordingly, reconsideration of the propriety of the rejection of claims 15 and 16 and its withdrawal is respectfully requested.

Regarding the rejection of claim 19 under 35 USC 103(a) as allegedly being unpatentable over Freerksen et al.:

Applicants traverse the Examiner's rejection of claim 19 as allegedly being unpatentable over Freerkesen et al.

The Patent Office alleges that Freerksen et al. discloses 1-cyclooctene-1-enyelthanone which has a similar structure as claimed by Applicant, wherein X is carbonyl, R is ethane and the double bond is located at a position between C1 and C2. However, the Patent Office acknowledges that the compound of Freerksen et al. does not have a double bond located in the position of C4 as required by claim 19. Moreover, the Patent Office alleges a prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities.

Freerksen et al. does not teach or suggest a fragrance including a compound selected from 1-cyclooct-3-enyl-2-methylpropan-l-one, 1-cyclooct-3-enylpropan-l-ol, 1-cyclooct-4-enylethanone, 1-cycloocty1-2-methylpropanone and 1-cycloocty1-2-methylpropanol as recited in amended claim 19. Nowhere does Freerksen et al. implicit or explicit give any indication that the compound of Freerksen is suitable as fragrance ingredient. Thus, Freerksen et al. fails to provide the relevant skilled artisan with a teaching, suggestion or incentive to incorporate the compound of Freerksen et al. into a fragrance as required in claim 19.

Because these features of independent claim 19 are not taught or suggested by Freerksen et al., the reference would not have rendered the features of claim 19 obvious to one of ordinary skill in the art.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience. The early issuance of a *Notice of Allowability* is solicited.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By _____

Andrew N. Parfomak, Esq.
Attorney for Applicant
Reg. No. 32,431
875 Third Avenue, 18th Floor
New York, NY 10022
Tel. 212-808-0700

CERTIFICATE OF TELEFAX TRANSMISSION UNDER 37 CFR 1.8

I certify that this document, and any attachments thereto, addressed to the: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" is being telefax transmitted to (571) 273-8300 at the United States Patent and Trademark Office.

Allyson Ross

Allyson Ross

6/11/08

Date

C:\ANPCMB\102790\189\Amendment01.doc